

AMENDMENTS TO THE DRAWINGS:

Please replace Sheet 2/Fig. 2 with the attached Replacement Sheet 2/Fig. 2.

REMARKS

Reconsideration of the present application is respectfully requested.

Claims 1-10 are pending in the present application. In the above amendments, claims 1 and 6-10 have been amended, and the Drawings and Specification have been amended. All of the amendments are fully supported throughout the specification, and no new matter has been added. Thereafter, after entry of the above amendments, claims 1-10 will be pending in this application. Applicant believes that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested.

Drawing Objections & Amendment to Specification

The drawings have been objected to because Fig. 2 does not show item 218 as referenced by the specification, paragraph 0017, line 3.

Applicants have attached Replacement Sheet 2/Fig. 2 that includes reference item 218. Additionally, Replacement Sheet 2/Fig. 2 further includes reference number 215, which corresponds to the amendment to paragraph 0017 of the Specification, as noted above. These amendments are fully supported throughout the Specification, and no new matter has been added.

Therefore, Applicant respectfully requests that the Examiner withdraw this objection.

Claim Objections

Claims 1-9 are objected to because of informalities. Applicant has revised claims 1, 6, 7, 8 and 9 as suggested by the Examiner. Thus, Applicant respectfully requests that the Examiner withdraw this objection.

Claim Rejections – 35 USC § 101

Claims 1-10 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter. Applicant hereby traverses this objection.

In order to expedite examination of the present application, although not necessitated by the present rejection, independent claims 1, 6 and 9 have been amended to recite that the “negative acknowledgement message includes deliberately arbitrary supplemental IPCP information and

does not include an IP address option *to extend the protocol synchronization period.*” Further, independent claim 10 has been amended to recite “triggering the PPP client to generate configuration request messages with deliberately arbitrary IPCP addresses *to extend the protocol synchronization period.*” Additionally, claims 1 and 10 have been amended to recite a “computer-implemented” method; claim 6 has been amended to recite a “computer-implemented” set of instructions; and claim 9 has been amended to recite a “computer-implemented” apparatus. These amendments are fully supported throughout the specification.¹

The rejection of claims 1-10 should be withdrawn for at least the following reason: claims 1-10 produce a useful, concrete and tangible result according to the relevant case law. In particular:

Because the claimed process applies the Boolean principle [abstract idea] ***to produce a useful, concrete, tangible result*** ... on its face the claimed process comfortably falls within the scope of §101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed. Cir. 1999) (Emphasis added); *See State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998). The inquiry into patentability requires an examination of the contested claims to see if the claimed subject matter, as a whole, is a disembodied mathematical concept representing nothing more than a “law of nature” or an “abstract idea,” or if the mathematical concept has been ***reduced to some practical application rendering it “useful.”*** *AT&T* at 1357 citing *In re Alappat*, 33 F.3d 1526, 31 1544, 31 U.S.P.Q.2D (BNA) 1545, 1557 (Fed. Cir. 1994) (emphasis added).

The Examiner contends that the methods of claim 1 and 10, and the apparatus of claims 6 and 9, do not create a tangible result specifying any use of the generated acknowledgment (claims 1, 6 and 9) or the generated configuration request (claim 10).

Applicants’ representative disagrees and submits the Examiner is misconstruing the requirements necessary to fulfill the conditions for patentability under 35 U.S.C. §101. According to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), the standard set forth by the Federal Circuit for determining whether claims are directed towards statutory subject matter is whether the claims as a whole can be applied in a practical application to *produce a useful, concrete and tangible result.* In particular, claims 1-9 recite methods and apparatus relating to a protocol synchronization period, which is clearly a practical application, and in which the “negative

¹ See, e.g., Specification, paragraphs 0024-0025 and 0039-0062.

acknowledgement message includes deliberately arbitrary supplemental IPCP information and does not include an IP address option *to extend the protocol synchronization period.*” As such, the recited subject matter is useful, concrete, and tangible, as the recited negative acknowledgement message has the practical application of extending the protocol synchronization period. This is clearly a useful, concrete and tangible result.

Further, claims 1-8 additionally recite “generating an acknowledgement message”, and claim 9 recites “means for generating an acknowledgement message”, wherein the acknowledgement message serves “to complete the protocol synchronization period.” Again, the recited subject matter is not a “law of nature” or an “abstract idea,” but is a concept that has been reduced to some practical application rendering it “useful.”

Additionally, Applicant further traverses the Examiner’s contentions that the recited subject matter “can be considered software” and that “software does fall within a statutory category”. The Court of Appeals for the Federal Circuit stated in *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005):

Title 35, section 101, explains that an invention includes “any new and useful process, machine, manufacture or composition of matter.” ... Without question, ***software code alone qualifies as an invention eligible for patenting under these categories***, at least as processes. *Id.* at 1338 (emphasis added).

Thus, the Federal Circuit in *Eolas Techs., Inc. v. Microsoft Corp.* established that software code alone is statutory subject matter. As such, to the extent that any of the recited subject matter may be considered software, by the standards set forth in the above decision, such software clearly falls within the categories of statutory subject matter.

Therefore, in view of the above remarks, it is readily apparent that the recited subject matter of claims 1-10 reduces to a practical application that produces a useful, concrete, tangible result. Thus, the subject claims are directed to statutory subject matter pursuant to 35 U.S.C. §101. Accordingly, Applicant requests the Examiner to withdraw this rejection.

Rejection of claims 1-6 and 9 under 35 USC § 102

Claims 1-6 and 9 are rejected under 35 USC § 102(e) as being anticipated by Liroy et al. (US Patent No. 6,483,822).

Applicant respectfully traverses this rejection as the cited reference does not disclose each and every element recited by the claims. For a prior art reference to anticipate, 35 U.S.C. §102 requires that

each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.²

Further:

To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’³

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.⁴

Claims 1-6 and 9 recite that a negative acknowledgement message “includes deliberately arbitrary supplemental IPCP information and does not include an IP address option.” The Examiner contends that the disclosure of “hint values” in col. 7, line 33 anticipates the recited subject matter. In particular, at col. 7, line 33, the recited subject matter discloses “a Configure-Nak comprising hint values.” The cited reference does not specifically disclose “deliberately arbitrary supplemental IPCP information”, as recited by the present claims. Further, the cited reference does not specifically disclose that the “negative acknowledgement message . . . does not include an IP address option,” as specifically recited by the present claims. Additionally, the cited reference does not specifically disclose that the negative acknowledgement message includes the combination of “deliberately arbitrary supplemental IPCP information and does not include an IP address option,” as recited by the present claims. Thus, the cited reference does

² *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999)(quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, USPQ2d 1051, 1053 (Fed. Cir. 1987)).

³ *Id.* (quoting *Continental Can co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)).

⁴ *Mehl/Biophile Int'l Corp. v. Milgram*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999), reh'g denied, 1999 U.S. App. LEXIS 31386 (Fed. Cir. Oct. 27, 1999) (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

not expressly disclose “each and every element as set forth in the claim[s],” as required by the statute.

Further, the Examiner has not provided the required “extrinsic evidence [that] ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’” Further, the Examiner is reminded that the “mere fact that a certain thing may result from a given set of circumstances is not sufficient” to establish inherency. In particular, with regard to claims 2-5, the Examiner attempts to supplement his initial argument with respect to claim 1, however, the Examiner has not provided any support for such statements.⁵

Therefore, based on the above remarks, the cited reference does not disclose each and every element recited by the claims. Thus, Applicant requests that the Examiner withdraw this rejection.

Rejection of claim 10 under 35 USC § 102

Claim 10 is rejected under 35 USC § 102(e) as being anticipated by Liroy et al. (WO 01/52499).

Applicant respectfully traverses this rejection as the cited reference does not disclose each and every element recited by the claims. In particular, Applicant has amended claim 10 to recite “triggering the PPP client to generate configuration request messages that include deliberately arbitrary supplemental IPCP information and that do not include an IP address option to extend the protocol synchronization period”, which is not disclosed or suggested by the cited reference.

For a prior art reference to anticipate, 35 U.S.C. § 102 requires that

each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.⁶

Further:

To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’⁷

⁵ See, e.g., Office Action mailed March 13, 2007, page 8 at lines 12-15, page 9 at lines 3-6, 10-13 and 17-20.

⁶ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999)(quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, USPQ2d 1051, 1053 (Fed. Cir. 1987)).

⁷ *Id.* (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir.

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.⁸

Claim 10 recites a “configuration request messages that include deliberately arbitrary supplemental IPCP information and that do not include an IP address option.” The Examiner contends that the disclosure of a “Configure-Nak message with an arbitrary IP address” at page 9, lines 24-25 anticipates the recited subject matter. The cited reference does not specifically disclose “deliberately arbitrary supplemental IPCP information”, as recited by the present claims. Further, the cited reference does not specifically disclose that the “negative acknowledgement message . . . does not include an IP address option,” as specifically recited by the present claims. Additionally, the cited reference does not specifically disclose that the negative acknowledgement message includes the combination of “deliberately arbitrary supplemental IPCP information and does not include an IP address option,” as recited by the present claims. Thus, the cited reference does not expressly disclose “each and every element as set forth in the claim[s],” as required by the statute.

Further, the Examiner has not provided the required “extrinsic evidence [that] ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’” Further, the Examiner is reminded that the “mere fact that a certain thing may result from a given set of circumstances is not sufficient” to establish inherency.

Therefore, based on the above remarks, the cited reference does not disclose each and every element recited by the claims. Thus, Applicant requests that the Examiner withdraw this rejection.

1991)).

⁸ *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999), reh'g denied, 1999 U.S. App. LEXIS 31386 (Fed. Cir. Oct. 27, 1999) (*quoting In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

Claims Rejections – 35 USC § 103

Claims 7-8 are rejected under 35 USC 103(a) as being obvious in view of Lioy et al. (US Patent No. 6,483,822) and in view of Lioy (WO 01/52499). Applicant respectfully traverses this rejection.

Applicant submits that a *prima facie* case of obviousness under 35 USC § 103 has not been established. In particular, the Applicants submit that Lioy et al. (US Patent No. 6,483,822), which qualifies as prior art only under 35 USC § 102(e), and the instant application are commonly owned by QUALCOMM Incorporated. In particular, please refer the assignments recorded at the following reel/frame: 010021/0805 (US 6,483,822); and 014975/0905 (Application No. 10/649,552). Furthermore, Applicants submit that such common ownership or an obligation of assignment to QUALCOMM Incorporated existed at the time the present invention was made. Accordingly, under 35 USC § 103(c), the cited reference is not available to preclude patentability under 35 USC § 103. Thus, a *prima facie* case of obviousness under 35 USC § 103 has not been established.

Therefore, based on the above remarks, Applicant requests that the Examiner withdraw this rejection.

CONCLUSION

In light of the amendments and remarks contained herein, Applicant submits that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

Dated: June 13, 2007

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